



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket: KATA-188

Applicants : Kazuhiko Ohnishi et al.
Serial No. : 10/761,400 Prior Art Unit: 1711
Filed : January 22, 2004 Primary Examiner: Irina S. Zemel
Title : CURABLE STARCH COMPOSITION, MODIFIED STARCH,
PREPARATION METHOD AND ARTICLES

REPLY – AMENDMENT
ELECTING INVENTION

Commissioner for Patents
Mail Stop: PETITION
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Office Action (dated August 29, 2005) required restriction to one listed invention and election of species for each of the substituents and linking group. The Amendment Electing Invention is enclosed.

Sept. 29, 2006
Date

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Title : CURABLE STARCH COMPOSITION, MODIFIED STARCH,
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AMENDMENT ELECTING INVENTION

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action of August 29, 2005, applicants submit the
following:

Restriction to one of the following inventions has been required under 35

U.S.C. 121:

- I. Claims 1 to 13 and 26 to 35, drawn to a curable starch composition.
- II. Claims 14, 20, and 36, drawn to a method of preparing a starch coating film and coated film.
- III. Claims 15, 21, and 37, drawn to a method of preparing a starch adhesive film and an adhesive article.
- IV. Claims 16, 22, and 38, drawn to a method of preparing a starch printing film and a printing film.
- V. Claim 17, 23, and 39, drawn to a method of preparing a curable starch sheet and a sheet.
- VI. Claim 18, 24, 40, drawn to a method of preparing a laminate and a laminate.
- VII. Claims 19, 25 and 41, drawn to a method of preparing a molded product.

Applicants elect, with traverse, the invention of Group I, Claims 1 to 13 and 26 to 35.

The Office Action stated: that this application contains claims directed to the following patentably distinct species of the claimed invention: different substituents (as per Claims 2 or 3) AND different linking groups (as per Claims 5 and 27); applicants are required to elect, for examination purposes a single ultimate species for EACH of the substituents and the linking group.

Applicants elect the species "isocyanate group" for Claims 2 and 3 (and 1, 4 to 10 and 26 to 35). Applicants, if required, the linking group "urethane linkage" for Claims 5 and 27 (and 1 to 3, 26 and 28 to 35).

The Office Action stated: that applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable; and that currently, claims 2, 3, 5, and 27 generic.

Applicants elect the species "isocyanate group" for Claims 2 and 3 (and 1, 4 to 10 and 26 to 35). Applicants, if required, the linking group "urethane linkage" for Claims 5 and 27 (and 1 to 3, 26 and 28 to 35).

The Office Action stated: that applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. This has been done.

The Office Action stated: that, upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

The Office Action stated: that a telephone call was made to Mr. Marsh on August 18, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

The Office Action stated: that applicants are advised that the reply to this requirement to be complete must include an election of the invention to be

examined even though the requirement be traversed (37 CFR 1.143). The election has been made.

Respectfully submitted,

Sept. 29, 2006
Date

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